

Remarks

The claims now in this case are claims 1-55, 58, 63, and 80-89. Claims 56-57, 59-62, and 71-79 were cancelled. The rejection of claims 1-15, 18-21, 23-31, 35-44, 49-52, 54-55, 58, and 63-70 was maintained for "reason of record" according to the Office Action of April 27, 2006. In the event that the compound claims are now found allowable, the examiner is respectfully requested to consider rejoinder of claims 64-67 and 69-70. Claims 64-67 are directed to the compounds of this invention in combination with other therapeutic agents for treatment of the same disorder. In this respect, they must be patentable as well if the compound of this invention is patentable, and accordingly no further search need be required. Similarly, claims 69-70 are directed to methods of therapy using the compounds herein, and if the compounds are patentable, the methods of their use should be patentable as well and, accordingly no further search need be required. See *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995).

In addition, Applicants have added claims 81-89 corresponding to claims 71-79. Applicants respectfully submit that added claims 81-89 should be rejoined upon allowance of the compound claims for the same reason stated above.

Applicants have also amended claim 45 to correct a grammatical error. Applicants maintain that no new matter is added by the amendment to claim 45.

Applicants have also amended claim 47 to correct a grammatical error. Applicants maintain that no new matter is added by the amendment to claim 47.

Applicants have also amended claim 49 to provide the definition of P. Support for the amendment can be found in original claim 49. Applicants maintain that no new matter is added by the amendment to claim 49.

Rejection Under U.S.C. § 101

Claims 22, 45, and 48 were rejected under 35 U.S.C. § 101 for statutory double patenting over claims 22, 45, and 48 of application 10/687,374. Application 10/687, 374 has since gone abandoned. Thus, the rejection should no longer be applicable.

Claims 1-21, 23-44, 46-47, 49-63, 68, and 80 were rejected under 35 U.S.C. § 101 for obviousness-type double patenting over claims 1-21, 23-44, 46-47, 49-63, and 68 of application

10/687,374. Application 10/687,374 has since gone abandoned. Thus, the rejection should no longer be applicable.

Rejection under 35 U.S.C. § 112

Claims 1-15, 18-21, 23-31, 35-44, 49-52, 54-55, 58, 63-70 were rejected under 35 U.S.C. § 112, second paragraph, with respect to the definition of Ar in the specification. The basis of the Examiner's rejection is not understood. Applicants respectfully direct the Examiner's attention to page 18, line 11 of the specification, where Ar is described as "any saturated, unsaturated or aromatic ring or ring system comprising a mono- or bicyclic carbocycle or heterocycle, *e.g.* 3 to 12 ring atoms (emphasis added)." As such, Ar can be a carbocycle (a C₃-C₁₂ carbocycle, C₃-C₁₂ substituted carbocycle), an aromatic ring (C₆-C₂₀ aryl, C₆-C₂₀ substituted aryl), or an aromatic heterocycle (C₂-C₂₀ heteroaryl, and C₂-C₂₀ substituted heteroaryl). Thus, the description of Ar at page 4 of the specification falls with the general description of Ar at page 18. Because there is no inconsistency in the descriptions of Ar at both pages 4 and 18 and the meaning of Ar is fully defined as required by § 112, Applicants respectfully request the rejection be withdrawn.

Claims 1-15, 18-21, 23-31, 35-44, 49-52, 54-55, 58, 63-70 were rejected under 35 U.S.C. § 112, second paragraph, with respect to the use of the term "prodrug moiety" in the claims as amended. The Examiner asserts that prodrugs must be pharmaceutically acceptable. Applicants respectfully submit that pharmaceutical acceptability of a prodrug is described in the specification. As defined in the specification at page 7, line 16, the term "pharmaceutically acceptable prodrug" means a compound that is metabolized in the host, for example hydrolyzed or oxidized, by either enzymatic action or by general acid or base solvolysis, to form an active ingredient. Furthermore, the specification provides specific examples of the prodrug moieties such as -CH₂OC(=O)R⁹, (POM)-CH₂OC(=O)C(CH₃)₃, (POC)-CH₂OC(=O)C(CH₃)₃ (see, for example, page 8, lines 1-14). Applicants respectfully submit that the meaning of "prodrug moiety" would be clear to a skilled person in the art, and is fully defined as required by § 112.

Claim 49, as amended, was rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Examiner notes that there is no written description of the claimed definition for the term "P" in claim 49 as amended. Applicants respectfully submit that support for the recitation of "P" can be found in claim 49 as originally filed.

Applicants believe that the claims as amended should be in condition for allowance. If, any additional extension or fee is required, please charge Account No. 07-1250.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jennifer L. Kisko".

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